2. Marked-up version of the abstract.

A correct marked-up version of the abstract is attached to accurately reflect all changes and deletions made to the original abstract.

This invention [relates to] provides a method [and]/process [for calculating]of determining a personal dietary supplement profile [for an individual] of vitamins, minerals, amino acids, enzymes, herbs, and other nutritional supplements [to obtain optimal health and wellness by completing] for an individual based on information from a health questionnaire [and optionally adding information provided by physical examination and laboratory studies] and comparing the individual's health information to [a standard] an ideal health profile in a computer data base. Optionally, information provided by physical examination and laboratory studies can be incorporated into the method/process of determining the dietary supplement profile. [The method and process further comprises a list of commercially available products that provide the items listed in the dietary supplement profile.] The profile can be further defined by listing commercially available products that provide the suggested dietary supplements.

Claims: Claims 2-3. Version with markings to show changes made:

2. The method/process of creating a dietary supplement profile of claim 1, wherein step (b) [further] comprises: [adding additional] comparing the questionnaire information by the individual and information provided by a physical examination to a health profile in a computer database.

3. The method/process of creating a dietary supplement profile of claim 1, wherein step (b) [further] comprises: [adding additional] comparing the questionnaire information by the individual and information provided by laboratory studies to a health profile in a computer database.

Remarks

In connection with the amendments, Applicant supplies the following remarks:

1. Claims 2-3 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point our and distinctly claim the subject matter with applicant regards as the invention.

Applicant has amended claims 2-3 to recite the steps involved in the method/process. Physical exam and lab results are added to the results of the health questionnaire prior to generating the dietary supplement profile.

2. Claims 1-5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Summerell et al (U.S. Pat. No. 5,937,387 in view of Riley (U.S. Pat. No. 5,976,568)

Claims 1-5 were rejected under § 103(a) as being unpatentable over Summerell. Summerell teaches a method to determine a user's current physiological age (Col.1, lines 10-11, claim 1).. Physiological age is defined as the "calendar age of an average person of the same gender with a comparable risk stratification level." (Col. 11, lines 25-27). Summerell provide various wellness plan options (Col. 3, lines 18-41) suggested to improve one's physiological age (Col. 2, lines 60-65). Summerell uses the information from the health profile questionnaire "to determine the user's relative risk stratification level" (Col. 9, line 35-37). In Figure 5, the questionnaire asks "Do you usually wear a seat belt?" Such questions have no significance in determining a dietary supplement profile, but in determining risk and calculating survival rate.

Summerell does not teach or suggest a method for creating a dietary supplement profile as inferred by the examiner. (Pg. 5, lines 15-16). Summerell offers no computer-controlled feedback loop by which the consequences of an event send back data that in turn modify that event in the

future. Summerell recommends the same amount of vitamin C, vitamin E and folate as in a one-size fits all vitamin tablet, provides no feedback to modify the amount of vitamins, and makes no reference to other vitamins, minerals, amino acids, enzymes or herbs. The Examiner admits that "it is unclear if the system/method of Summerell adjusts for differences between the individuals health information when compared to an optimal health profile then generates a dietary supplement profile suggested for an optimal health profile." (Pg. 6, lines 20-21, Pg. 7, lines 1-2). This admission by the examiner nullifies any rejection for obviousness under § 103. The Court in *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984) held that in determining obviousness, one must consider the invention as a whole; small differences between the claims and the prior art can therefore give rise to patentability.

Summerell teaches the recognition of high blood pressure as a risk factor, but offers no dietary supplement profile to counteract the risk. Summerrell recommends the use of exercise, stress reduction, salt restriction, weight loss, decrease alcohol consumption and anti-hypertensive medication (Fig. 24). No individual dietary supplement plan is taught or suggested in the recommendation. His wellness plan considers total and HDL cholesterol, but only recommends reducing dietary cholesterol, exercise and an alcoholic drink at night (Fig. 18, 20, 22, 23). The weight loss recommendation in Fig 24 offers no individual plan but suggests a 10% reduction in weight. If such a recommendation had any chance of success there would be no rampant obesity and no weight loss centers in this country.

In the Applicant's invention, the amount of dietary supplements are adjusted to reflect changes in an individual's needs. See page 3, lines 22 to page 4, line 11. Summerell offers no dietary supplement profile listing the vitamins, minerals, amino acids, enzymes and herbs suggested for an optimal health profile.

Applicant's invention uses information created by a health questionnaire and the addition of information provided by a physical exam and laboratory studies to generate a computer-implemented dietary supplement profile and a list of commercially available products to obtain an optimal health profile. Summerrel offers no such dietary supplement profile of vitamins, minerals, amino acids, enzymes and herbs, but makes general recommendations to reduce risk factors to calculate a survival rate.

The Examiner erred when she cited *In re Van Geuns*, 988 F.2d 1181 (Fed Cir. 1993) to allege that limitations from the specifications are not read into the claims. Van Geuns copied claims 1-4, 9 and 10 from Brown's patent (4,587,504) into his application as claims 42-47. The PTO determined that Van Geun's claims corresponded substantially to the Count because they define the "same patentable invention." 988 F.2d at 1183. The PTO was considering the patentability in an interference proceeding. A vehicle for testing the priority of an invention.

Riley teaches a method of providing seven (7) multi-vitamin and mineral formulations, referred to as modules. These modules are described on Column 4, lines 44-67 and column 5, lines 1-21. "Module 1, the basic formula, is directed to the general public and consists of vitamins and minerals essential for the prevention of vitamin and mineral deficiency diseases." There is no mechanism in the invention to determine what vitamin or mineral deficiencies exist. "Module 2 is a Stress Formula." Module 3 consists of "specific doses of vitamin, minerals and other compounds." "Module 4 contains aspirin." "Module 5 is essentially Module 1 combined with about 20 mg of aspirin within the AM tablet." "Module 6 is also essentially Module 1, but combined with about 81 mg of aspirin with the AM tablet." "Module 7 which is the same as the low dose formulation in Module 3, but combined with about 81 mg of aspirin." How does one know which module to take?

Riley offers no system/method of determining what modules to take. Riley teaches away from the invention of the applicant. Riley teaches that "[t]he use of laboratory methods to assess nutritional status, which includes blood and tissue levels of vitamins and their effects (A, C, E, D, etc) on various enzyme systems (B1, B2, B6), is often considered the most reliable method of assessing nutritional status, though these special testing procedures are expensive and do not exist in standard medical offices or in many hospital clinical laboratories (Col. 2, lines 42-49). Riley goes on to state that "certified nutrition assessments, the expenses involved, and the time required to conduct necessary history taking, physical examination and appropriate laboratory testing, it is apparent that consumers are forced into making their own nutrient supplement choices." (Col. 2, lines62-66). The benefits of the applicant's invention are taught away by Riley. The Supreme Court held in *United States v. Adams*, 383 U.S. 39, 148 USPQ 497 (1966) that one important indicium of nonobviousness is "teaching away" from the claimed invention by the prior art, and that the prior art's teaching away was held to prevent a purported § 103 rejection.

The Examiner cited *In re Keller*, 642 F.2d 413 (CCPA 1981) to support the position that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Ex. Br. Pg. 11, lines 1-3). Keller involved a appeal regarding a reissue application. The prior art in the reissue was not cited during prosecution of the original patent application. The Court held that "...the test is what the combined teaching of the references would have suggested to those of ordinary skill in the art." 642 F.2d at 422.

The Applicant's claims differ from Summerell and Riley and a claim of obviousness cannot be made. The CCPA and the Federal Circuit has consistently held that when a § 103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention

disclosed in the reference, such a proposed modification is not proper and the prima facie case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Applicant therefore submits that obviousness by Summerell and Riley is not legally justified and is therefore improper. Applicant submits that the rejection on these references is also improper and should be withdrawn.

Conclusion

It is the Applicant's belief that any final action regarding this application is premature, and raises this issue for consideration by the Examiner. MPEP § 706.07(c). The examiner may withdraw the rejection of finally rejected claims. MPEP § 706.07(e). Applicant requests a personal interview to discuss the merits of the application. MPEP § 714.12. For all of the above reasons, Applicant submits that the final office action mailed on September 11, 2002 is not final, but the second office action. Applicant submits that the Response to the Office Action is consistent with the requirements of 35 U.S.C. § 112, 2nd paragraph, and § 103(a). In the alternative, Applicant submits this response as an Amendment after final office action. If for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. § 706.03(d) and § 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Respectfully submitted,

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